

THIS DISPOSITION IS
NOT CITABLE AS PRECEDENT
OF THE TTAB

Mailed: May 19, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Christian Des Garets

Serial No. 76281704

Lawrence E. Abelman and Julie B. Seyler of Abelman Frayne & Schwab for Christian Des Garets.

Ronald McMorrow, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Simms, Chapman and Bucher, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Christian Des Garets (an individual, citizen of France) filed an application on July 5, 2001, to register on the Principal Register the mark ESSENTIAL DE PERRON RIGOT for goods amended to read "essential oils for personal use, depilatory waxes and preparations, lotions or substances for use in the depilatory process" in International Class 3. The application is based on applicant's assertion of a bona fide intention to use the

mark in commerce. The application includes the following statements, all accepted by the Examining Attorney and entered into the record : (1) "Applicant is the owner of 1,490,735 for PERRON RIGOT";¹ (2) "The English translation of ESSENTIAL DE PERRON RIGOT is Essentials of Perron Rigot"; and (3) "PERRON RIGOT does not identify the name of a living individual."

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its identified goods, so resembles the registered mark ESSENTIALS for the following goods:

"cosmetics, namely mascara, eyeshadow, eyeliner, eyebrow pencil, foundation, concealer, lipstick, blush, face powder, and lip liner; fragrances, namely, men's and women's cologne and perfume; beauty preparations, namely, skin moisturizing cream, skin toner, skin cleansing cream, and makeup remover; nail care preparations, namely, nail polish, top coat, polish remover, base coat and hardener; men's and women's shampoo; and hair care preparations, namely, conditioner, hair spray, styling mousse, and styling gel" in International Class 3,²

¹ Registration No. 1,490,735 issued June 7, 1988, for the mark PERRON RIGOT (in stylized lettering) for "perfumed water, perfumed oil, milk lotion, skin lotion, toilet cream, hair dye, manicure enamel, depilatory, toilet soap, hair shampoo, dentifrices" in International Class 3; Section 8 accepted.

² Registration No. 1,687,493, issued May 19, 1992; Section 8 affidavit accepted, Section 15 affidavit acknowledged; renewed.

as to be likely to cause confusion, mistake or deception.

When the refusal was made final, applicant appealed. Briefs have been filed, but applicant did not request an oral hearing.

We reverse the refusal to register. In reaching this conclusion, we have followed the guidance of the Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The Examining Attorney contends that applicant has adopted the singular form of the registered mark and added applicant's own previously registered mark thereto; that the addition of applicant's house mark does not obviate a likelihood of confusion; that the term "ESSENTIAL[S]" suggests for both applicant's and registrant's goods that the goods are "necessary" or "essential" items, and that they are scented, making the commercial impression of both

applicant's and registrant's marks similar; that the dominant portion of applicant's mark is the term "ESCENTIAL," which is nearly identical to the cited registered mark ESSENTIALS; that the respective goods are closely related and are offered through the same channels of trade; and that doubt is resolved in the cited registrant's favor.

The Examining Attorney submitted (i) printouts of several third-party registrations to show that the goods of both applicant and the cited registrant frequently emanate from a common source under a single mark; and (ii) a copy of the search report from his search of the USPTO records showing that there are only four "hits" for the word "ESCENTIAL[S]," to show that the term is not weak in the relevant fields.

Applicant argues that the registered word ESSENTIALS "is the phonetic, verbal and connotative equivalent of the word ESSENTIALS" (brief, p. 2); that "essentials" is a term of art in the beauty and personal care fields; that "escentials" is merely a misspelling of the highly suggestive or descriptive word "essentials" in the personal care industry, and the numerous third-party registrations which include the term "ESSENTIALS" in the cosmetic, skin care and hair care fields, establish that the registered

mark is entitled to only a limited scope of protection because consumers are confronted with numerous such marks and will distinguish between them; that the misspelling of a highly suggestive or descriptive word does not change the significance of the word; that, in addition, applicant's mark contains the arbitrary, distinct and dominant element "PERRON RIGOT" (a registered mark owned by applicant); that, when considered in their entities and not dissected into separate parts, applicant's mark and the registered mark are appreciably different in sound, appearance, connotation and create substantially different commercial impressions; and that applicant's goods are inherently different from and are commercially unrelated to the goods described in the cited registration.

Turning first to the involved goods, it is well settled that goods (or services) need not be identical or even competitive to support a finding of likelihood of confusion; it being sufficient that the goods (or services) are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See *In re Peebles Inc.*, 23 USPQ2d 1795 (TTAB 1992); and *In re*

International Telephone and Telegraph Corporation, 197 USPQ 910 (TTAB 1978).

It has been repeatedly held that, when evaluating the issue of likelihood of confusion in Board proceedings regarding the registrability of marks, the Board is constrained to compare the goods (or services) as identified in the application with the goods (or services) as identified in the registration. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank of Commerce, N. A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

In this case, the cited mark is registered for a wide variety of cosmetics, fragrances, beauty preparations, nail care preparations and hair care preparations, while applicant intends to offer "essential oils for personal use, depilatory waxes and preparations, lotions or substances for use in the depilatory process." The Examining Attorney submitted printouts of numerous third-party registrations, based on use in commerce, listing these types of goods in connection with the same marks. See e.g., Registration No. 2,569,522 for, *inter alia*, "essential oils for personal use" and "soaps, perfumes,... moisturizing lipsticks and hair lotion"; and Registration

No. 2,529,699 for, inter alia, "essential oils for personal use" and "nail polish, eyebrow pencil,... blush, lipstick,... mascara, eyeliner,... perfume, cologne,..."

When considering the third-party registrations submitted by the Examining Attorney, we are aware that such registrations are not evidence that the marks shown therein are in use or that the public is familiar with them. Such third-party registrations nevertheless have some probative value to the extent they may serve to suggest that such goods (or services) are of a type which emanate from the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, footnote 6 (TTAB 1988).

In view of the foregoing evidence, we find that applicant's essential oils and depilatory products and registrant's various personal care and beauty products are related within the meaning of the Trademark Act.

With regard to the channels of trade, in the absence of any specific limitations thereon in the respective identifications of goods, the Board must assume that the goods travel in all the normal channels of trade to all the usual classes of customers for such goods. See *Octocom Systems Inc. v. Houston Computers Services Inc.*, supra; and *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir.

1983). As there are no limitations on the channels of trade in either identification of goods, we, accordingly, find that the goods travel in the same or overlapping channels of trade.

Turning to a consideration of the marks, it is well settled that marks must be considered and compared in their entirety, not dissected or split into component parts so that parts are compared with other parts. This is because it is the entire mark which is perceived by the purchasing public, and therefore, it is the entire mark that must be compared to any other mark. It is the impression created by each of the involved marks, each considered as a whole, that is important. See *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992); and *Franklin Mint Corp. v. Master Manufacturing Co.*, 667 F.2d 1005, 212 USPQ 233 (CCPA 1981). See also, 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §23:41 (4th ed. 2001).

Marks are compared in terms of their appearance, sound, and connotation. In terms of appearance, sound and connotation, applicant's four-word mark and the cited registrant's one-word mark are quite dissimilar. While the first part of applicant's mark is similar to the registered mark, that portion sounds identical to the word

"essentials," which is a part of the generic term for one of applicant's identified goods ("essential oils for personal use"), and this misspelling would not, of course, be recognized when applicant's mark is pronounced. Rather, to consumers, applicant's mark would sound like "essential (oils) of Perron Rigot."

In terms of connotation, both marks contain the word "ESSENTIALS" which, as argued by the Examining Attorney, could connote both the idea of "necessary" and "scented." (In addition, as explained above, in applicant's mark the word "escential" could also connote "essential oils.") In any event, applicant's mark, when considered as a whole, includes the additional source-indicating words "DE PERRON RIGOT," translated as "of Perron Rigot." Consumers would perceive that the words "ESSENTIAL DE PERRON RIGOT" specifically relate to PERRON RIGOT; and they may be familiar with applicant's mark PERRON RIGOT.

On this ex parte record, we find that applicant's mark, considered in its entirety, creates a different commercial impression from that of the cited registered mark. See *In re Hearst Corp.*, 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992) (VARGA GIRL and VARGAS, both for calendars, held not confusingly similar); *Food Specialty Co., Inc. v. Kal Kan Foods, Inc.*, 487 F.2d 1389, 180 USPQ 136 (CCPA

1973)(KITTY for cat food and KAL KAN KITTY STEW and design for canned cat food held not confusingly similar); Lever Bros. Co. v. Barcolene Co., 463 F.2d 1107, 174 USPQ 392 (CCPA 1972)(ALL for household cleansing products and ALL CLEAR! in stylized lettering for a household cleaner held not confusingly similar, by majority opinion); Colgate-Palmolive Co. v. Carter-Wallace, Inc., 432 F.2d 1400, 167 USPQ 529 (CCPA 1970)(PEAK for dentifrice and PEAK PERIOD for personal deodorants held not confusingly similar, by majority opinion); and Electronic Realty Associates, Inc. v. Kayser-Roth Corp., 216 USPQ 61 (TTAB 1982)(ERA for a variety of clothing items and GOLDEN ERA for sportshirts held not confusingly similar).

Moreover, the Examining Attorney accepted applicant's translation of its mark (even though the translation did not state from what language it was translated into English); and that translation refers to "ESSENTIAL" as translated to "Essentials." Applicant has submitted search results from a private database to show that the term "essential[s]" is a weak term with limited protection in the personal care and related fields. The Examining Attorney's argument that there is only one registered mark for the word ESSENTIALS in the relevant field (acknowledging that there is a registration which includes

the term for incense and one which includes the term for fertilizer) is not sufficient to persuade us that these marks, when considered in their entirety, are similar in sound, appearance, connotation and commercial impression. See *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976).

Decision: The refusal to register under Section 2(d) of the Trademark Act is reversed.